

REMARKS

Claims 1-9 were pending. In the present response, Applicants have amended claims 1 and 9 and added new claims 10-12, leaving claims 1-12 pending in the present application for the Examiner's consideration. No new matter has been added.

In summary of the Office Action of May 7, 2002, the Examiner has:

I. Rejected Claims 1-9 under 35 U.S.C. §112 , paragraph 2, for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention; and

II. Rejected Claims 1-9 under 35 U.S.C. §103(a) as being unpatentable over *Wang et al.*, U.S. Patent No. 5,237,679, ("*Wang*") in view of *Schmid et al.*, U.S. Patent No. 5,569,164, ("*Schmid*").

The Applicants respectfully traverse the Examiner's rejections.

I. Rejection of Claims 1-9 under 35 U.S.C. §112

The Examiner rejected Claims 1-9 under 35 U.S.C. §112 for failing to provide sufficient antecedent basis for the term "the stack object" as it appears in Claims 1 and 9. Claims 1 and 9 have been amended to address this rejection, and the Applicants respectfully request the withdrawal of this rejection.

II. Rejection of Claims 1-9 under 35 U.S.C. §103

The Examiner rejected claims 1-9 as unpatentable under *Wang* in view of *Schmid*. The Applicants respectfully submit that Claims 1-9 are patentable over the *Wang* in view of *Schmid* because the references fail to disclose or suggest all of the elements of the pending claims.

As noted in the specification, "despite the advantages of the electronic form, the paper form of a document still has retained some advantages over conventional electronic

documents." (Specification, p.1). The operation of stapling is one advantage of paper documents. "Stapling provides an association between the papers that are being stapled." (Specification, p.2). Stapling has several functions. First, "once stapled, a stack of papers can be manipulated as a unit as it is stored, transported, or the like." (Specification, p.2). Additionally, "stapling is an indication that a paper document is complete and removed staples are generally observable on paper documents." (Specification, p.2).

One object of the present invention is to provide a "virtual stapling" capability for permanently or semi permanently associating arbitrary electronic documents with each other. (Specification, p.6). Once stapled, electronic documents can be manipulated together as a single unit, analogous to their paper counterparts. In an embodiment, the virtual stapling operation is "cryptographically enforced so that no document can be altered or removed from the collection." (Specification, p.6). For example, Claim 1 recites, in part, "cryptographically securing the staple data object in response to receipt of the staple instruction." Claim 9, as amended, recites, in part, "cryptographically securing the stack object in response to receipt of the staple instruction." Applicants respectfully assert that neither *Wang* nor *Schmid* disclose or suggest these claim elements.

Wang discloses "a *temporary* stapler document relationship [that] may be created by stapling a first document to a second document." (*Wang*, Abstract) (emphasis added). *Wang* discloses an "access control model object 44 . . . generally contain[ing] access control information which may be utilized to identify those users or groups of users to whom some form of access authority has been granted." (*Wang*, col. 4, lines 37-44). Thus, *Wang* discloses protecting documents by limiting document access to specific groups of users. *Wang* does not disclose using cryptography to prevent documents from being altered or removed.

Moreover, there is no motivation to modify the teachings of *Wang* to disclose the claimed inventions. *Wang* emphasizes that its stapling operation is to "establish a *temporary* relationship between one or more data objects or documents." (*Wang*, Col. 3, line 67 - Col. 4, line 1) (emphasis added). In contrast, the claimed inventions

cryptographically secure the associations between documents to make the associations permanent or semi-permanent. Because the stapling operation disclosed by *Wang* only temporarily relates documents, there is no need in *Wang* for a mechanism to cryptographically enforce the stapling relationship so that no document is altered or removed. Therefore, Applicants respectfully submit that *Wang* does not disclose or suggest the cited elements of Claims 1 and 9.

Similarly, *Schmid* does not disclose or suggest the cited elements of Claims 1 and 9. *Schmid* discloses a "system enabling a computer to identify the beginning and end of a logical group of digitally scanned documents . . . through the use of cover pages or sheets containing machine-readable information." (*Schmid*, Abstract). *Schmid* does not disclose or suggest any use of virtual staples or cryptography, let alone "cryptographically securing" electronic documents as required by Claims 1 and 9. Since neither *Schmid* nor *Wang* disclose or suggest the cited elements of Claims 1 and 9, the Applicants respectfully submit that Claims 1 and 9 are patentable over *Wang* in view of *Schmid*.

Claims 2-8 are dependent on Claim 1, and Claims 10-12 are dependent on Claim 9. Applicants respectfully submit that these dependent claims are patentable over *Wang* and *Schmid* by virtue of their dependence on patentable independent claim.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

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PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

11/7/02 JMH
Date

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APPENDIX

IN THE SPECIFICATION:

The paragraph on page 3, beginning at line 18, with markings to show changes is as follows:

Figure 1 shows a stapler system 100 comprising a stack staging area 102 and a stapler form 104. It should be understood that stapler system 100 could be implemented in any manner of digital computer environment, and to the extent that the environment is well known in the art, it is not described here. One such environment that might be used is that described in [U.S. Patent No. _____ (U.S. Application Ser. No. 09/_____, filed _____, 1998) U.S. Application Ser. No. 09/303,818, filed April 30, 1999 and entitled "Method and System for Processing Documents Controlled by Active Documents with Embedded Instructions"; that application is commonly owned with the present application and is incorporated by reference herein for all purposes[]]. In that system, operations such as stapling are handled by active documents, such as stapler form 104 shown in Figure 1.

IN THE CLAIMS:

- 1 1. (Presently Amended) In an electronic document handling system, a
- 2 method of manipulating documents comprising the steps of:
- 3 generating a staple data object, for representing an association of selected pages and
- 4 selected documents;
- 5 generating an electronic cover sheet for the [stack] staple data object;
- 6 accepting from a user a list of at least one page of at least one electronic document;
- 7 referencing each page or each electronic document in the list as an item of the [stack]
- 8 staple data object;
- 9 accepting a staple instruction from a user; and

10 cryptographically securing the staple data object in response to receipt of the staple
11 instruction.

1 9. (Presently Amended) In an electronic document handling system,
2 a method of associating documents comprising the steps of:
3 generating a [staple data] stack object, for representing an association of selected
4 pages and selected documents;
5 generating an electronic cover sheet for the stack object;
6 accepting from a user a list of at least one page of at least one electronic document;
7 referencing each page or each electronic document in the list as an item of the stack
8 object;
9 accepting a staple instruction from a user;
10 cryptographically securing the [staple data] stack object in response to receipt of the
11 staple instruction;
12 opening a secured stack upon receipt of a stack open instruction;
13 presenting the contents of the secured stack for perusal by the user;
14 accepting additions and deletions of items on the secured stack; and
15 resecuring the secure stack upon receipt of a stack restaple operation.